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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,259	09/21/2005	Masahiro Hagiwara	Q90407	1176
23373 7590 03/23/2011				
SUGHRUE MION, PLLC				
2100 PENNSYLVANIA AVENUE, N.W.				
SUITE 800				
WASHINGTON, DC 20037				
EXAMINER				
NAKARANI, DHIRAJLAL S				
ART UNIT		PAPER NUMBER		
1787				
NOTIFICATION DATE		DELIVERY MODE		
03/23/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/550,259

**Applicant(s)**

HAGIWARA ET AL.

**Examiner**

D. S. Nakarani

**Art Unit**

1787

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 9-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-5 and 9-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For the reasons of record set forth in paragraph 3 of the Office Action mailed October 18, 2010 (Paper Number 20101007).
3. Claims 1-5 and 9-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 14-20 and claim 14, lines 8-14, the phrase "the content of the dispersion-----the tin-doped indium oxide fine particles, respectively" renders claims indefinite and confusing. The Examiner is unable to determine the meaning of the said phrase. It is not clear how one can determine means and bound of the claimed composition.

Claim 27, lines 15-20, the content of the organic acid-----oxide fine particles" renders claims indefinite. From the claim language it is not clear the basis for calculation of recited % by weight of organic acid and of phosphate ester-based compound. Furthermore % by weight of chelate is not specified in the claim. Therefore the total content of the chelate, the organic acid and phosphate ester-based compound is in a range of 26.7 to 60 parts by weight

relative to 100 parts by weight of the tin-doped indium oxide fine particles can not be understood.

4. Claims 1-5 and 9-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo (U. S. Patent 6,329,061 B2) in view of Kobata et al (U. S. Patent 6,673,456 B1) and Mont et al (U. S. Patent 4,027,069) for the reasons of record set forth in paragraph 4 of the Office Action mailed April 23, 2010 (Paper Number 20100420).

5. Applicant's arguments filed January 18, 2011 have been fully considered but they are not persuasive. In reference to rejection of claims 1-5 and 9-26 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, applicants essentially argue that claim 1 as amended does not include case (1) in which 20.7% by weight of the dispersion stabilizer and 10% by weight of the tin-doped indium oxide fine particles and case (2) in which 6% by weight of the dispersion stabilizer and 60% by weight of the tin-doped indium oxide fine particles.

These arguments are unpersuasive because the amended claim 1 still reads on above mentioned cases (1) and (2). Applicants have not provided any explanation how those cases are obviated from the scope of claimed invention. Furthermore, applicants have not given any calculation showing bases for support of added limitation in claim 1, lines 17-20.

In reference to rejection of claims 1-5 and 9-26 under 35 U.S.C. 103(a) as being unpatentable over Kondo (U. S. Patent 6,329,061 B2) in view of Kobata et al (U. S. Patent 6,673,456 B1) and Mont et al (U. S. Patent 4,027,069), applicants essentially appears to argue that Kobata et al do not teach or suggest content of the claimed three components of the dispersion stabilizer in any of the examples. Also neither Kondo nor Mont et al teach or suggest

claimed features (a) to (c) stated on page 14, lines 4-9 of the amendment filed January 18, 2011.

These arguments are unpersuasive because combination of references teaches addition of claimed three components to prepare dispersion. Kobata et al do not teach concentrated dispersion of tin-doped indium oxide fine particles. However making concentrates of additives for making final product by adding desired quantity of concentrate of additives is well known in the art.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/D. S. Nakarani/  
Primary Examiner, Art Unit 1787**

DSN  
March 15, 2011.